

REMARKS

I. Status of claims

Claims 1-33 are pending in this application. By this Amendment, claims 1-3, 9, 16-18, 24, and 31-33 have been amended. Reconsideration is respectfully requested in view of the above amendments and the following remarks.

II. Claim Rejections

A. Rejection under 35 U.S.C. §101

Claims 1-33 have been rejected under 35 U.S.C. §101 based on an allegation of non-statutory subject matter. This rejection is respectfully traversed.

The Office Action asserts that the limitation “carrier” causes all of claims 1, 16, and 31-33 to be non-statutory. This assertion is respectfully traversed as having no basis in patent law, patent rules, or in PTO guidelines.

The independent claims as amended all define statutory subject matter. Claim 1 is directed to a computer-implemented method, claim 16 is directed to a computer system, claim 31 is directed to a computerized system, claim 32 is directed to a computer readable medium, and claim 33 defines a computer-implemented method. All of the aforementioned claims fully comply with the statutory requirements of 35 U.S.C. 101.

The claims define a process falling within the categories of statutory subject matter defined by 35 U.S.C. 101. The pending claims are not directed to any exception to 35 U.S.C. 101 statutory categories, which include abstract ideas, laws of nature, and natural phenomena as set forth in MPEP 2106. 35 U.S.C. 101 creates statutory categories and exceptions to those

statutory categories. The claims of the application fall squarely within the defined statutory categories including a process, machine, manufacture, or composition of matter and do not fall within any of the exceptions to statutory subject matter.

The burden is on the USPTO to set forth a *prima facie* case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation. It is believed in the present instance, that the Examiner is interpreting the “carrier” as a signal and is therefore rejecting the entirety of each claim as non-statutory. First, as will be more fully explained below, the “carrier” may be interpreted to be a file or a document or a plurality of files or documents, but cannot be interpreted as a signal. Even if the “carrier” were to be interpreted as a signal, its inclusion in the claims would not render the claims non-statutory.

For example, as set forth in MPEP 2106.01, computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence non-statutory.

With respect to the “carrier”, as explained on page 10, lines 17-19 of the originally filed application, the media independent carrier may be an electronic package containing the list file,

the XML file and the XSLT file. Furthermore, as set forth on page 11, lines 1 and 2, delivery of the carrier may be carried out over a network connection or via portable media. For example, the carrier may be or include one or more computer-readable files file storing content. The files may be stored on a portable storage medium. The carrier itself, which is described herein as a computer-readable “file” or “files” is transported along with the information that it stores. In described embodiments, the files include an Extensible Stylesheet Language Transformation (XSLT) document, and an extensible markup language (XML) document, and a list file. The XSLT file may store the logic used to parse the list file. See page 16, lines 12-21.

Further, as set forth on page 11, lines 6-11, the presentation channels should be equipped with processing tools capable of handling the media independent carrier. Such processing tools may import the electronic package, unpack the data, content, and rules files, populated the content with variable data based on the rules, and generate outputs for publishing in the channel. Thus, the carrier in preferred embodiments is plurality of files. Claim 4, for example defines the carrier as comprising a plurality of style tags that may be present, for example, in an HTML file.

As set forth in MPEP 2106.01, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d

Because all of claims 1-33 qualify as statutory under the guidelines set forth in 35 U.S.C. §101, withdrawal of the rejection is respectfully requested.

B. Rejection under 35 U.S.C. §112

Claims 1-33 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

With respect to the phrase, “delivering the plurality of data to multiple presentation channels”, Applicant respectfully submits that this phraseology is correct. The data is delivered “to” the presentation channel, for example over a computing network. Exemplary presentation channels and the nature of delivery are described for example on page 10, line 20- through page 11, line 11. The presentation channels will typically be managed by and equipped with processing tools as explained on page 11, first full paragraph. In the example of FIG. 5, for example as set forth on page 16, lines 19-24, the list file and campaign content package are delivered to a “print vendor”. The print vendor in this instance is considered to be the “distribution channel” for the purposes of claim interpretation.

With respect to claims 3 and 18, applicant respectfully submits that financial products as set forth herein references those products offered by a financial institution, such as, for example, credit cards, debit cards, bank accounts, other savings vehicles, mortgages, other types of loans, etc. Applicant believes that those skilled in the art would concur with this definition of a financial product.

With respect to Style tags, these tags are known to those skilled in the art as features present in various types of files such as HTML files. More specifically, style tags provide a way

to define style rules within a document's HTML head tag. The style rules may help authors to set visual attributes such as font size, color, and type. Style tags can be used to define in-line style information, for example when styles may be varied throughout a document.

With respect to claims 6, 21, and 33, Applicant respectfully submits that as set forth in the original specification on page 9, lines 15-17, media-independent format refers to the "formats of the content being independent from the media types in which it will be presented."

With respect to "lines of business", as defined, for example, in Wikipedia, Line of Business (LOB) is a general term which often refers to a set of one or more highly related products which service a particular customer transaction or business need.

Applicant respectfully submits that all claim terminology is clear and definite and therefore withdrawal of the rejection is respectfully requested. If the Examiner continues to have issues with the claim terminology, Applicant is entirely willing to discuss appropriate modifications.

C. Rejection under 35 U.S.C. §102

Claims 1-3, 15-18, and 30-32 have been rejected under 35 U.S.C. §102(b) as being anticipated by George et al. (2002/0095481, hereinafter George). This rejection is respectfully traversed.

George discloses a system for allowing customization of content of product information. The customization is achieved by storing customer behaviors in response to receipt by the customer of system data. George discloses associating customer behavior with stored products

by a set of rules and sending an email to the customer based on the relationship between the customer behavior and the stored products.

George fails to disclose several features of the pending claims "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

For example, with respect to independent claim 1, George fails to disclose managing, for an organization, a plurality of data and a plurality of content in separate database entities, wherein the plurality of content is associated with the plurality of data based on a plurality of rules, the plurality of rules controlling a logical combination and physical layout of the plurality of data and plurality of content. George also fails to disclose packaging the plurality of rules with the plurality of content in a carrier that is independent from multiple presentation channels. George further fails to disclose delivering the plurality of data and the carrier to the multiple presentation channels and integrating, at the multiple presentation channels, the plurality of data with the plurality of content based on the plurality of rules in order to logically integrate the data and content and control the physical layout of the integrated data and content. George further fails to disclose distributing the integrated data and content through the multiple presentation channels.

Accordingly, because George fails to disclose each and every feature of claim 1, George fails to anticipate claim 1. Claims 2, 3, and 15 depend from claim 1 and therefore define over the art of record for at least the reasons set forth above with respect to claim 1.

Claim 16 includes limitations parallel to those identified above with respect to claim 1. Accordingly, George fails to disclose the limitations as set forth above and does not anticipate the invention of claim 16. Claims 17, 18, and 30 depend from claim 16 and are thus allowable over the art of record for at least the reasons set forth above with respect to claim 16.

Claims 31 and 32 are independent means-plus-function and computer-readable medium claims respectively. These claims include limitations parallel to those referenced above with respect to claim 1 and are accordingly allowable over the art of record for the reasons set forth above. Withdrawal of the rejection of claims 1-3, 15-18, and 30-32 under 35 U.S.C. §102 is respectfully requested.

D. Rejection under 35 U.S.C. § 103(a) of Claims 4, 9, 10, 12, 14, 19, 24, 25, and 27

Claims 4, 9, 10, 12, 14, 19, 24, 25, and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over George in view of Quatse et al. (2005/0010472, hereinafter Quatse). This rejection is respectfully traversed.

Even if combined, George and Quatse would not have resulted in the inventions set forth in the above-identified claims. Accordingly, a *prima facie* case of obviousness cannot be established. In order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981,

180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994).

With respect to claims 4 and 19, the addition of Quatse fails to obviate the above-noted deficiencies of George with respect to claims 1 and 16. Furthermore, the Examiner’s assertion that Quatse discloses style tags that are associated with the plurality of content based on the plurality of rules is respectfully traversed. Quatse simply contains no such disclosure.

With respect to claims 9 and 24, the addition of Quatse fails to obviate the above-noted deficiencies of George with respect to claims 1 and 16. Although Quatse does disclose multiple channels, Quatse fails to disclose any explicit disclosure of integration of the plurality of data with the plurality of content is further based on specific needs of the multiple presentation channels.

Furthermore, with respect to claims 10, 12, 14, 25, 27, and 29, Quatse fails to obviate the above-noted deficiencies of George with respect to claims 1 and 16. Accordingly, these claims define over the art of record for at least the reasons set forth with respect to claim 1 and 16. Because a *prima facie* case of obviousness has not been established, withdrawal of the rejection is respectfully requested.

E. Rejection under 35 U.S.C. §103(a) 6-8, 11, 13, 21-23, 26, and 28

Claims 6-8, 11, 13, 21-23, 26, and 28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over George. This rejection is respectfully traversed.

With respect to claims 6 and 21, Applicant respectfully traverses and requests clarification of the Official Notice. The Examiner states that it is “old and well known to store information in different formats that may be compatible with different systems.” Applicant does not accept that it was well known at the time of the invention to store content in a media independent format in a single system as required by claim 6. Perhaps storage in different formats for different systems was known, but this knowledge has little relation to claim 6, which requires the plurality of content to be stored “in at least one media-independent format.” Furthermore, Applicant respectfully submits that claims 6 and 21 define over the art of record for at least the reasons set forth above with respect to independent claims 1 and 16.

If Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the Examiner must support the finding with adequate evidence. See MPEP §2144.03 It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379

With respect to claim 7, 8, 22, and 23 Applicant respectfully traverses the Official Notice stating that the plurality of content packaged based on an extensible markup language (XML) and the plurality of rules based on XSL transformations (XSLT) language were old and well known and that would have been obvious to modify the system accordingly. Applicant respectfully requests the production of a teaching in similar context prior to the date of the invention, that could have led one of ordinary skill in the art to develop the claimed invention.

Furthermore, Applicant respectfully submits that claims 7, 8, 22, and 23 define over the art of record for at least the reasons set forth above with respect to independent claims 1 and 16.

With regard to claims 11, 13, 26, and 28, these claims also define over the art of record for at least the reasons set forth above with respect to independent claims 1 and 16.

Thus, because the references, even if combined would not have resulted in the invention of claims discussed above, and further because no motivation would have been present to modify George in the stated manner, the references fail to render obvious the invention of the above-identified claims. Withdrawal the rejection under 35 U.S.C. §103 is therefore respectfully requested.

F. Rejection under 35 U.S.C. §103(a) of claims 5 and 20

Claims 5 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over George in view. of U.S. Patent No. 6,009,410 to LeMole et al (hereinafter “LeMole”). This rejection is respectfully traversed.

LeMole fails to obviate the deficiencies of George noted above. Thus, claims 5 and 20 define over the art of record for at least the reasons set forth above with respect to independent claims 1 and 16. Thus, because the references, even if combined would not have resulted in the invention of claims discussed above, and further because no motivation would have been present to modify George in the stated manner, the references fail to render obvious the invention of the above-identified claims. Withdrawal of claims the rejection under 35 U.S.C. §103 is therefore respectfully requested.

F. Rejection under 35 U.S.C. §103(a) of claim 33

Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over George in view of LeMole and further in view of Quatse. This rejection is respectfully traversed.

Claim 33 defines a combination of features addressed above with respect to the independent and dependent claims. Claim 33 defines over the art of record for at least the reasons explained above pertaining to the features contained in claim 33. Accordingly, withdrawal of the rejection with respect to claim 33 is respectfully requested.

G. Treatment of claim 29 on the merits

Applicant notes that claim 29 has not been treated on the merits in this first non-final Office Action and respectfully requests treatment on the merits or an indication of allowability.


III. Conclusion

As set forth above, applicants respectfully submit that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicants have overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Respectfully submitted,

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